

### **REMARKS**

Claims 1-38 [sic] were pending in the application. Claims 1, 2, 4, 5, and 8-38 [sic] have been withdrawn from consideration as being drawn to a non-elected invention. Claims 3, 6, and 7 have been amended in the application. Accordingly, claims 3, 6, 7 are presented for reconsideration and reexamination in view of the following remarks.

In the outstanding Office Action claims 3, 6, and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) Figure 1 in view of U.S. Patent No. 6,772,386 to Iwata et al.

By this Amendment claims 3, 6, and 7 are amended and remarks are provided regarding each of the cited references. Support for the amendments to claim 3 can be found, for example, on page 24, paragraph beginning on lines 20 and 32, and on page 25, paragraph beginning on lines 8 and 30. Additionally, the terminology "steps of" has been deleted from claims 6 and 7 along with minor changes for clarity.

It is further respectfully submitted that the within amendments introduce no new matter within the meaning of 35 U.S.C. §132.

#### **Rejection Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 3, 6, and 7 as being unpatentable over AAPA Figure 1 in view of Iwata et al.

As amended, Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen,

Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

It is respectfully submitted that the combination of AAPA Figure 1 and Iwata et al. fails to teach or suggest all the claim limitations.

The feature of the present invention resides in a recording method in which an input data word of 8 bits is subjected to 8-15 modulation with a plurality of coding tables to obtain a code word of 15 bits as clearly recited in amended claim 3.

In contrast in AAPA Figure 1, an 8-14 and an 8-16 modulation method are used.

Further, Iwata et al. discloses a digital signal processing method, data recording and reproducing apparatus, and data recording medium that are resistant to burst errors. In column 8, lines 41-47, data is subjected to 8-16 modulation.

Applicants respectfully submit that the 8-15 modulation recited in claim 3 of the present invention is quite different from conventional modulations such as the 8-14 modulation and the 8-16 modulation discussed on pages 1-4 of the specification of the instant application. For example, as discussed on page, paragraph beginning on line 25 of the specification of this application, the 8-15 modulation is performed to satisfy the run length restriction rule  $RLL(d, k)=RLL(2, 10)$  having a minimum run length of  $3T$  and maximum run length of  $11T$ . In contrast, on page 2, paragraph beginning on line 6, "...inputted 8-bit (1 byte) digital data is converted to 14-bit run length limited code (hereinafter referred to as a code word) satisfying the run length restriction such that the minimum run length is  $3T$  and the maximum run length is  $11T$ ." Further, on page 2, paragraph beginning on line 27, "...8 to 16 modulation is executed so

as to satisfy the run length restriction rule RLL (2, 10) that the minimum run length is 3T and the maximum run length is 11T.”

In view of the above distinctions, Applicants respectfully submit that the present invention as recited in independent claim 3 patentably defines over the AAPA Figure 1 and Iwata et al. taken either alone or in combination.

Further, Applicants submit that dependent claims 6 and 7 are also patentable by virtue of at least their dependency on independent claim 3.

As the combination of references fails to teach or suggest all the claim limitations, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

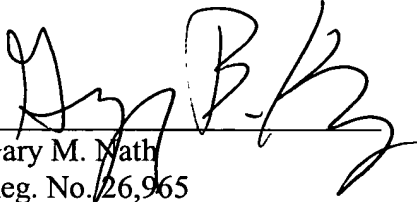
### CONCLUSION

In light of the foregoing, Applicants submit that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,  
**NATH & ASSOCIATES PLLC**

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NATH & ASSOCIATES PLLC  
1030 15<sup>th</sup> Street, N.W.  
6<sup>th</sup> Floor  
Washington, D.C. 20005  
Tel: (202) 775-8383  
Fax: (202) 775-8396

  
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Gary M. Nath  
Reg. No. 26,965  
Gregory B. Kang  
Reg. No. 45,273  
Teresa M. Arroyo  
Reg. No. 50,015  
Customer No. 20529